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Applicant : James D. Redmond, et al. Art Group No.: 3722
Serial Number : 09/090,067 ✓ Examiner: Mark T. Henderson
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Honorable Assistant Commissioner Of Patents
Washington, D. C. 20231

AMENDMENTUNDER 37 C.F.R. § 1.116 AND RESPONSEREQUEST FOR RECONSIDERATION OF FINALITY ANDAMENDMENT UNDER C.F.R. 116

Dear Sir:

In response to the Office Action dated July 5, 2001, a response was due October 5, 2001, a Petition and fee for a two month Extension of Time for the filing of this Amendment and the Notice of Appeal up to and including December 5, 2001, a response and a Notice of Appeal are filed herewith. The Applicants respectfully request reconsideration of the finality of the office action dated July 5, 2001. A response to the Office Action (Final Office Action) dated July 5, 2001 is also enclosed. All rejections in the Office Action are based on the '461 UK patent. While Applicants appreciate the Examiner's contentions, Applicants do not believe the rejections are correct as they are

based on incorrect interpretation of the '461 UK patent. Arguments are set forth below to traverse the rejections in an effort to quickly move the application towards allowance, or place the issues in better form for Appeal. Claims 1, 3, 4, 5, 11, 13, 14, 15, 21, 23, 24, 25 have been amended, without prejudice, and do not necessitate a search or raise new issues. **To this end, Applicants respectfully request entry of the amendments and reconsideration of the arguments to place the application in condition for allowance or place the issues in better form for Appeal.**

REQUEST FOR RECONSIDERATION OF FINALITY

In the referenced Office Action, the Examiner introduced "a new ground of rejection that is neither necessitated by the Applicants' amendment of the claims nor based on information submitted in an information disclosure statement" (MPEP §706.07 (a)). As stated in the interview summary for the telephone interview dated May 30, 2000, the Applicants' amendments aimed to "more clearly define claim language with respect to color contrasting on the document area". The amendments submitted on June 22, 2001 modified the scale to be a **micro** scale. The second scale had been defined as a micro scale in the specification. For example, p. 2, line 29 teaches to "graphically reproduce the first printed matter at a smaller scale" and in p. 3, lines 2-3 the teaching is described as "the large scale printed matter on the document which has been duplicated elsewhere on the document in micro-printed text". Thus, the second scale was defined as a micro-scale in the original specification. See also p. 5, lines 17-18 ("The printed matter on card 10, however, also includes micro-printed matter which is printed at a second, significantly smaller scale.") and p. 7, line 30 ("cards with card specific micro-printed text"). Thus, second scale as used in the specification explicitly includes micro

scale. Therefore, while further elucidating, the June 22, 2001 amendment did not introduce a new limitation. From which it should be apparent that "a new ground of rejection" was "neither necessitated by the Applicants' amendment of the claims nor based on information submitted in an information disclosure statement" (MPEP §706.07 (a)).

Furthermore, since second scale had been defined as a micro scale in the specification, it should have reasonably anticipated that it "might be incorporated into applicant's amendments". (MPEP §904.02). Since the original search should have covered "all subject matter" which should have been anticipated to "be incorporated into applicant's amendments" (MPEP §904.02), and since second scale had been defined as a micro scale in the specification, the "new ground of rejection" was not "necessitated by the Applicants' amendment of the claims" (MPEP §706.07 (a)). Thus, the final rejection is not proper.

The Applicants respectfully request reconsideration of the finality of the office action dated July 5, 2001.

AMENDMENT AND RESPONSE

In response to the Office Action dated July 5, 2001, with a three month shortened statutory period for response, please amend the above-referenced application as follows: